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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,518	11/14/2003	Frank L. Greenway	99042-00	9982

7590 12/07/2005

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EXAMINER

JONES, DAVID B

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/713,518	Applicant(s) GREENWAY ET AL.	
	Examiner David B. Jones	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 29-44 is/are pending in the application.
- 4a) Of the above claim(s) 30-44 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Newly submitted claims 30-44 are directed to an invention that is distinct from the invention originally claimed. Since Applicant has received an action on the merits for the originally presented invention, the invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30-44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142 (b) and MPEP 821.03.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 9-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall. Hall teaches the claimed chain including a plurality of links 10/11, a plurality of rod-shaped coupling members 12, an end connection member 15 having an opening in its cylindrical side wall, and end links at 16/16. In response to Applicant's argument that the use of the chain around a waist is a limitation on the structure, it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from the prior art article, if the prior art article teaches all the structural limitations of the claim. See *Ex parte Masham*, 2 USPQ2d 1647 (1987). Applicant has only called for links, coupling members, and at least one connection member; the prior art teaches element for element this structure.

The fact that the chain is used on a waist of a wearer imparts no structure to these elements of the combination and fails to differentiate them from the prior art.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8, and 14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall. Hall teaches the claimed invention excepting 1) the making of the links from stainless steel, 2) the making of the end link removably attachable, and 3) the making of the end connection permanently connectable to at least one of the ends of the chain. Regarding the first exception, Hall fails to particularly set forth the material of his bead chain, but the making of bead chains from non-corrosive material, so that a person wearing the chain will not be stained, is well known. The wearing of ball chains are well known and have been used for the wearing of identifying badges, etc., for some time and well before the filing of the instant application. The Examiner takes official notice of such chains and the fact people have worn them and that they have been made from non-staining materials. Assuming arguendo, to have made the chain of Hall from a stainless steel or other material that is non-staining to the wearer of the chain would have been to the artisan of ordinary skill in the art but an obvious choice of chain making expedients to prevent staining of the wearer. Regarding the second exception, Hall teaches permanently attached end links 16 on the ends of his chain. It would have been obvious to one of ordinary skill in the art to have used removable links if so

desired to make a smaller or bigger chain and hence meet the wearer's demands.

Finally with respect to the latter exception, Hall teaches the connector to be removable with respect to either end of the chain to which it is connected; however it would have been obvious to one of ordinary skill in the art at the time of the invention to have crimped one end of the connector member 15 around an end link 16 to prevent the unintentional disconnection of the chain from the wearer.

4. Claim 29 is allowed.

5. The declarations of Drs. Greenway and Fujioka under 37 CFR 1.132 filed 9/13/2005 are insufficient to overcome the rejection of claims 1-15 based upon a showing not commensurate in scope with the claims at hand and a showing of facts not germane to the rejection of the last office action. Claim 29 has been allowed. This claim is drawn to the method of using a chain in the use of weight loss. The declarations are drawn to this concept and the concept is allowed. Claims 1-15 are drawn to a chain per se and as treated supra are treated for their structure only. The structure of the chains are not treated in the Declarations and hence the arguments or facts are not commensurate to the scope of the claim, i.e., a chain having a plurality of links, a plurality of coupling members, and at least one connection member, etc. Further the declarations are not germane to the rejection, i.e., showing that the structure set forth in the prior art does not meet the structure set forth in applicant's claims. Hence the declarations fail to overcome the rejections under 35 USC 102 and 103.

6. Applicant's arguments with respect to claims 1-15 have been considered but they are not persuasive. As treated supra, the claims are treated for their limitations on the

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article, namely a chain. The intended use of an article is given little if any weight; article claims are treated for their structure and not their use. The prior art structure teaches element for element the claimed chain and applicant has failed to show the intended use of the chain imparts any structure to the combination, hence patentability is precluded under 35 USC 102 (b).

7. **THIS ACTION IS MADE FINAL.** See MPEP 706.07 (a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-Month** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136 (a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

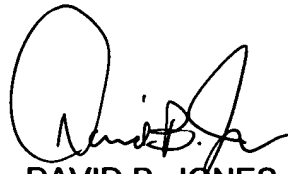
9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David B. Jones whose telephone number is (571) 272-4851.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3700.

In the event that the Applicant (s) wishes to communicate via Fax number for Group 3700 is (703) 872-9306.

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wahp

A handwritten signature in black ink, appearing to read "David B. Jones", written over a printed name.

DAVID B. JONES
PRIMARY PATENT EXAMINER
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